



R. Kent
1/7/04
#11 / Election
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Brian POND et al.

Group Art Unit: 3711

Serial No.: 10/016,179

Examiner: Sebastiano Passaniti

Filed: October 30, 2001

For: GOLF CLUB HEAD WITH INSERT

FURTHER RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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Sir:

In response to the Office Action mailed October 17, 2003, applicants hereby provisionally elect, with traverse, Species I corresponding to Figures 1-4, upon which and claims 1-29 and 31-39 in this application are readable. Claims 1, 21 and 34 are generic to all Species I-III.

Claim 1 is generic to Species I (Figs. 1-4) because it recites head 10, having center section 20 (see specification at page 6, first full paragraph, referring to Figs. 1 and 2), and

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insert 25 (see specification at page 8, lines 11-12, describing Figs. 1-4).

Claim 1 is generic to Species II because Figs. 5 and 6 show head 90, center section 20 and insert 25.

Claim 1 is generic to Species III because Figs. 7 and 8 show head 80, center section 20 and insert 25. Contrary to the statement in the Office Action, Fig. 7 shows reference numeral 20 associated with a center section and insert 25 located therein. The specification at page 10, line 2, states that Fig. 7 shows head 80 having insert 25 (and likewise Fig. 8 because both Figs. 7 and 8 show head 80). Therefore, the Office Action is wrong in suggesting that Species III (Figs. 7 and 8) does not show a cavity for receiving an insert.

Claim 21 is generic to Species I (Figs. 1-4) because it is directed to head 10 plus face insert 17 in strike face 15, wherein the cavity is structured to receive a rear-insert 25, as shown in Figs. 1-3 (see specification at page 11, third paragraph, describing Figs. 3 and 8). Fig. 3 shows head 10 having face-insert 17. Thus, claim 21 is included in Species I.

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Claim 21 is generic to Species II because Figs. 5 and 6 show head 90, center section 20 and insert 25. Figs. 5 and 6 show a particular view that hides strike face 15 and face-insert 7, but page 7, lines 7-9, states that "the features and characteristics with reference to golf club head 10 may be attributed to both golf club head 80 and 90," where head 90 is shown in Figs. 5 and 6. Thus, the face-insert described for head 10 also is present in head 90.

Claim 21 is generic to Species III because Figs. 7 and 8 show head 80, center section 20 and a face-insert 17, and they also show insert 25, which resides in a cavity for receiving such insert 25, but such cavity simply is not visible because insert 25 is assembled into it. An "insert" necessarily resides in a "cavity." Contrary to the statement in the Office Action, Fig. 7 shows reference numeral 20 associated with a center section and insert 25 located therein. Also, the above-quoted passage stating that all of the attributes of head 10 (Figs. 1-4) apply to head 80 (Figs. 7 and 8). Therefore, the Office Action is wrong in suggesting that Species III (Figs. 7 and 8) does not include a cavity for receiving an insert.

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Claim 34 is generic to Species I because it recites head 10, the toe and heel comprising 80% of the head weight, and a transparent insert 25. The specification at page 6, first full paragraph, states that Figs. 1 and 2 show a head having at least 80% of the weight in the toe and heel. The specification at page 11, lines 1-3, states that insert 25 shown in Fig. 1 can be transparent.

Claim 34 is generic to Species II because Figs. 5 and 6 show head 90, center section 20 and insert 25, and for the same reason quoted above herein, i.e., the features and characteristics with reference to golf club head 10 are attributed to golf club head 90. Therefore, transparent insert 25 of head 10 and toe and heel comprising 80% of the head weight of head 10 also apply to head 90 of Species II.

Claim 34 is generic to Species III for the same reason quoted above herein, i.e., the features and characteristics with reference to golf club head 10 are attributed to golf club head 80. Figs. 7 and 8 show head 80, center section 20 and insert 25, which is transparent as stated in the above-quoted passage. Contrary to the statement in the Office Action, Fig. 7 shows

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reference numeral 20 associated with a center section and insert 25 located therein, and the specification at page 10, line 2, states that Fig. 7 shows head 80 having insert 25. Therefore the Office Action is wrong in suggesting that Species III (Figs. 7 and 8) does not include a cavity for receiving a transparent insert.

Accordingly, claims 1, 21 and 34 are generic to all Species I-III.

In addition to claims 1, 21 and 34, claims 2-20, 22-33 and 35-39 are readable upon Species I for the following reasons:

<u>Claim</u>	<u>Salient Element</u>	<u>Citation Relating to Figs. 1-4</u>
1	Discussed separately herein above.	
2, 26	80% weight	Page 6, first full paragraph
3	90% weight	Page 6, first full paragraph
4	Wall thickness	Page 6, first full paragraph
5,27,35	Insert: causes increased natural frequency	Page 10, line 4
6	Insert dampens vibration	Pg 11, second full Paragraph
7,29	Transparent insert and sight line on floor	Page 11, lines 1-3

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<u>Claim</u>	<u>Salient Element</u>	<u>Citation Relating to Figs. 1-4</u>
8,9	Insert weights	Page 10, third paragraph
10,12	Insert material	Page 11, second paragraph
11	Insert transparent	Page 11, lines 1-3
13	Hosel in insert	Page 7, lines 1-2 (hosel Fig. 2 shows insert 25 in center section 20 having aperture for receiving hosel)
14,15,31,36	Vapor deposit	Page 13, second paragraph, describing embodiment 10
16,32,39	Types of heads	Page 13, third paragraph, describing embodiment 10
17,28,33,37	Coupled dampener	Page 11, first full paragraph
18	Dampener material	Page 11, second full paragraph describing embodiment 10
19	Dampener thickness	Page 11, second full paragraph describing embodiment 10
20, 38	Dampener sound	Page 11, first full paragraph describing embodiment 10
21	Discussed separately herein above.	
22	Face-insert Materials	Page 12, first full paragraph describing embodiment 10
23,24	Face-insert % Area	Page 13, second full paragraph and page 12, lines 1-2 referring to Figs 3-8 as describing embodiment 10

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<u>Claim</u>	<u>Salient Element</u>	<u>Citation Relating to Figs. 1-4</u>
25	Face-insert: Bayshore rebound	Same as claims 23,24 only third full paragraph
34	Discussed separately herein above.	

Applicants again respectfully traverse the election of Species requirement because the subject matter of all of claims 1-39 is sufficiently related that a thorough and complete search for the subject matter of the elected claims should necessarily encompass a thorough and complete search for the subject matter of the non-elected claims. Thus, search and examination of the entire application can be made without serious burden. See MPEP §803 in which it is stated that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits." This policy should

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apply in the present application to avoid unnecessary delay and expense to applicant and unnecessary duplicative examination by the USPTO.

Respectfully submitted,

PARKHURST & WENDEL, L.L.P.



Date

Roger W. Parkhurst
Registration No. 25,177
Robert N. Wieland
Registration No. 40,225

RWP:RNW/ame

Attorney Docket No.: CLEV:564

PARKHURST & WENDEL, L.L.P.
1421 Prince St., Ste. 210
Alexandria, VA 22314-2805
Tel: (703) 739-0220